

Application Serial No.: 10/529,071

REMARKS

Status Summary

Claims 1-8 and 15-36 are now pending in the subject U.S. patent application. Claims 17-20 and 22-36 have been withdrawn pursuant to a Restriction/Election Requirement issued by the U.S. Patent and Trademark Office (hereinafter "the Patent Office"). Accordingly, claims 1-8, 15, 16 and 21 have been examined by the Patent Office. Claims 1-8, 15, 16 and 21 presently stand rejected.

Claims 1-8, 15, 16 and 21 have been rejected under 35 U.S.C. §102(a/e) upon the contention that the claims are anticipated by PCT Patent Application Publication WO 02/26192 to Van Meir et al. (hereinafter "Van Meir et al.").

Claim 2 has been canceled herein. Claim 1 has been amended to more particularly recite the presently disclosed subject matter. Support for the amendment can be found throughout the specification, including particularly at page 6, lines 19-27, and in original claim 2. No new matter has been added.

New claims 37-39 have been added. Support for the new claims can be found throughout the specification, including particularly at page 6, lines 16-27, and in original claims 1-4. No new matter has been added.

Reconsideration of the application based on the amendments and arguments set forth herein is respectfully requested.

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*Response to the Rejection of Claims under 35 U.S.C. § 102(a/e)*

Claims 1-8, 15, 16 and 21 have been rejected under 35 U.S.C. §102(a/e) upon the contention that the claims are anticipated by Van Meir et al. The Patent Office contends that Van Meir et al. teaches each and every element of claims 1-8, 15, 16 and 21.

The contentions of the Patent Office as summarized above with respect to the rejected claims are respectfully traversed as described below.

Initially, applicants respectfully submit that claim 2 has been canceled without prejudice. Accordingly, applicants respectfully submit that the instant rejection as it applies to claim 2 has been rendered moot.

Applicants note that it is well settled that for a cited reference to qualify as prior art under 35 U.S.C. §102, each element of the claimed subject matter must be disclosed within the reference. "It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention." Hybritec, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986). Thus, applicants respectfully submit that for the cited reference to be an anticipation reference under 35 U.S.C. §102, the reference must disclose each and every element of the claimed subject matter.

Without acquiescing to the contentions of the Patent Office, applicants respectfully submit that independent claim 1 has been amended herein as follows:

1. An adenovirus vector comprising an adenovirus gene and a transgene, each under the transcriptional control of a transcriptional regulatory element (TRE) comprising a minimal promoter and a hypoxia